

THE OFFICE ACTION

In the Office Action issued on January 13, 2005, the Examiner rejected claims 1-10 under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement. The Examiner further rejected claims 1-10 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,539,254 to O'Connor ("O'Connor")

REMARKS

Applicants have carefully considered the Office Action issued on January 13, 2005. Applicants respectfully request reconsideration of the application in light of the following comments.

A. The Pending Claims Satisfy §112

The Examiner rejected claims 1-10 under 35 U.S.C. §112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and use the invention. Specifically, the Examiner objected to the fact that no chain length limitations were provided for the UF polymer, the amount of short stop agent used in the system and the time at which the short stop agent is added.

Applicants submit that no specific values were provided for the above mentioned parameters as they may vary depending on the characteristics desired in the final product. That is, by varying the amount of short stop agent added as well as the predetermined time at which it was added to the UF resin polymerization reaction, different UF resins may be manufactured having various properties. Applicants submit that various manufacturer's of such short stopped UF resins may alter their polymerization processes to make various suitable UF resins. One skilled in the art could determine appropriate UF polymerization conditions including the appropriate amount of short stop agent and timing to produce desired properties in the UF resin according to the present claims. As is well known, a disclosure is sufficient even if it would require that one skilled the art conduct some

experimentation. *In re Vaeck*, 20 USPQ2d 1510 (Fed. Cir. 1993).

Applicants submit that these claims thus satisfy §112, first paragraph, irrespective of the fact that the amount of short stop agent added to the UF resin is not disclosed. Suitable amounts based on desired properties could be determined without undue experimentation by one skilled in the art. The Dynea resin used in the disclosed examples is but one formulation by one manufacturer.

B. The Pending Claim are not Obvious Over O'Connor

The Examiner rejected claims 1-10 under 35 U.S.C. §103(a) as being unpatentable over O'Connor. Applicants respectfully traverse.

O'Connor has been cited previously by the Examiner in combination with U.S. Patent Application Publication No. 2002/0117279 to Wertz. In that Office Action, the Examiner acknowledged that O'Connor did not disclose the use of a short stop agent in the preparation of the UF resin. The Examiner is now contending that the UF resin of O'Connor is equivalent to the short-stopped UF resin of the present claims and asserts that "a minor amount of shortstop agent could be added towards the polymerization process which would result in a minimal impact on the structural and physical characteristics of the polymer."

Applicants respectfully disagree and submit that the Examiner has not met her burden of presenting a prima facie case of equivalence between the UF resin of O'Connor and the short-stopped UF resin of the present application. In this respect, to render a product by process claim unpatentable, the Examiner must show that the product is the same as or obvious from a product in the prior art. To meet her prima facie burden of this, the Examiner must provide some supported rationale or explanation to show that the claimed product is the same as that in the prior art. Here, the Examiner has provided no such rationale besides her unsupported allegation that a minor amount of short stop agent would result in a minimal impact on the characteristics of the polymer. Where does the Examiner find support for this statement?

Applicants have shown in Example 1 of the specification that the short stopped UF resin produces products having improved properties. Thus, such a UF resin is clearly different both in structure and properties from conventional UF resins as in O'Connor. What more does the Examiner desire to show these differences?

Applicants submit that the Examiner has NOT met her burden of proving prima facie obviousness and that the burden has NOT shifted to the Applicants to prove distinctiveness of the short-stopped UF resin. Applicants further submit that it requires some scientific support to shift this burden and that the Examiner's unsupported allegations of sameness are insufficient.

Because O'Connor does not disclose or suggest the use of a short-stopped UF resin, it fails to anticipate or render the present claims obvious. Withdrawal of this rejection is requested.

CONCLUSION

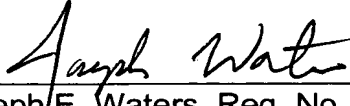
In view of the foregoing comments, Applicants submit that claims 1-10 are in condition for allowance. Applicants respectfully request early notification of such allowance. Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned to attempt to resolve any such issues.

If any fee is due in conjunction with the filing of this response, Applicants authorize deduction of that fee from Deposit Account 06-0308.

Respectfully submitted,

**FAY, SHARPE, FAGAN,
MINNICH & MCKEE, LLP**

Date: April 12, 2003



Joseph E. Waters, Reg. No. 50,427
1100 Superior Avenue
Seventh Floor
Cleveland, OH 44114-2518
216/861-5582